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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,728	08/05/2003	David M. Chess	YOR920030230US1	8862
29683	7590	09/21/2006	EXAMINER	
HARRINGTON & SMITH, LLP 4 RESEARCH DRIVE SHELTON, CT 06484-6212			LEWIS, CHERYL RENE	
			ART UNIT	PAPER NUMBER
			2167	

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/635,728	Applicant(s) CHESS ET AL.	
	Examiner Cheryl Lewis	Art Unit 2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Office Action is in response to the applicants' communication received on June 30, 2006.
2. Claims 1-33 are presented for examination.
3. The applicants have amended claims 1, 2, 11-13, 18, 20, 21, and 29-33 in the amendment received on June 30, 2006. No claims have been cancelled and there was no amendment to the Specification in the amendment received on June 30, 2006.
4. Applicants' arguments with respect to claims 1-33 have been considered and a tentative (proposed) agreement was discussed with the applicants' representative, attorney David O'Neill, in an interview held on September 13, 2006. The results of that interview are reflected in the Office Action presented below.

#### ***Continued Examination Under 37 CFR 1.114***

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on June 30, 2006 has been entered.

**Remarks**

6. In the interview held on September 13, 2006, the claim limitations were discussed. It was tentatively agreed that one of the outstanding features of the applicants' invention is element 120 and sub-element 121 and 122 along with the feature components and other feature elements in which they interact and produce data (i.e. figure 1, elements 104-141).

***Continued Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1, 13, 18, 20, 29, 30, 31, and 33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As follows:

In the last step of claim 1, the claim limitation is directed to users submitting the meta-queries. In the last step of claim 13, the claim limitation is directed to providing the predictions to users submitting later queries. Likewise, the last steps of claims 18 and 33, the claim limitation is directed to providing the enhanced performance prediction data to users. In the last step of claim 31, the claim limitation is directed to receiving enhanced performance prediction information from the performance prediction service in response to the metaquery. Claims 1, 13, 18, 20, 31, and 33 are non-statutory because the claims comprise a step in which queries are submitted, a query is responded to, and enhanced performance prediction data is provided to users. These claim limitations are not producing a tangible result. It appears that a specific action

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should follow these claimed limitations. For instance, in claims 1 and 13, the limitations state that users submit later queries, however the claim limitations are silent about what happens and/or what action is produced as a result of the later queries being submitted. In the above recited claim limitations for independent claims 1, 13, 18, 20, 30, and 33, after the queries are submitted, after the queries are responded to, and after enhanced performance prediction data is provided, then is the tangible result to display information to users in an effort to access information or is there any other action that is performed in which this particular action produces a tangible result?

Independent claims 29 and 30 are also non-statutory for the reasons presented in the above paragraph. Claims 29 and 30 do not comprise the outstanding claim limitations of element 120 and sub-elements 121 and 122.

Further as to the claims, they are further rejected under 101 because they recite computer program product on a computer readable media and the media or medium in the specification corresponds to non tangible media such as transmission media including carrier waves and for these reasons the claims do not have results which are useful concrete and tangible. The examiner suggests amending claim 13 to recite "a computer program stored on a computer readable ~~media~~ storage device"; amend claim 20 to state that the "computer program product" is executed and stored on a "storage device", likewise dependent claims 21-28 should recite a "device"; amend claim 29 to recite "a computer readable ~~media~~ storage device" and claim 29 should have "comprising" to separate the preamble from the body of the claim; claims 30 and 31 should recite that the system is being implemented by hardware (computer

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implemented); and claim 33 should recite "a computer readable ~~media~~ storage device, the ~~computer program product~~ storage device comprising:".

Thus, the remaining claims are dependent (2-12, 14-17, 19, 21-28, and 32) claims, these claims are also rejected for the reasons stated in the Office Action presented above.

***NAME OF CONTACT***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (571) 272-4113. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

(571) 273-4113 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

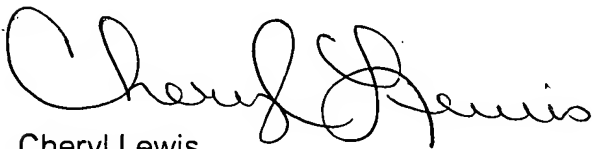
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/ Technology Center (571) 272-2100.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Cheryl Lewis". The signature is fluid and cursive, with the first letter "C" being particularly large and stylized.

Cheryl Lewis  
Patent Examiner  
September 16, 2006